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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,416	04/17/2006	Sherman Fong	P1995R1	8968
9157 7590 05/08/2008 GENENTECH, INC. 1 DNA WAY SOUTH SAN FRANCISCO, CA 94080				
EXAMINER				
WOODWARD, CHERIE MICHELLE				
ART UNIT		PAPER NUMBER		
1647				
MAIL DATE		DELIVERY MODE		
05/08/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/533,416

**Applicant(s)**

FONG ET AL.

**Examiner**

CHERIE M. WOODWARD

**Art Unit**

1647

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-9 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/17/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-850)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 9/5/07, 6/13/07, 08/24/05

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Groups 2879 and 2878 (recited as Groups 1479-2956 drawn to SEQ ID NOs: 1399 and 1400) in the reply filed on 3/27/2008 is acknowledged. The traversal is on the ground(s) that claims 7, 8, and 9 can be searched together. This is not found persuasive because the instant case is a national stage filing under 35 USC 371 and the examiner previously found a lack of unity in the case (see Requirement for Restriction/Election mailed 2/28/2008) (see also MPEP 1850). The requirement is still deemed proper and is therefore made FINAL.

2. Although Applicant was instructed to identify ONE SEQ ID NO, corresponding to the correlated group, the examiner will rejoin Groups 2879 and 2878, because Group 2879 is directed to claim 7 as it reads on SEQ ID NO: 1400 and Group 2878 is directed to claim 7 as it reads on SEQ ID NO: 1399. Applicant has pointed out that SEQ ID NO: 1399 is the nucleic acid encoding the polypeptide of SEQ ID NO: 1400.

3. Claims 7, 8, and 9 are pending. Claims 8 and 9 are withdrawn from consideration. Claim 7 is under examination as being drawn to SEQ ID NOs: 1399 and 1400.

### ***Information Disclosure Statements***

4. The information disclosure statements (IDS) submitted on 8/24/2005, 6/13/2007, and 9/5/2007 have been considered. Signed copies are attached hereto.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Chang, US Patent 5,741,772, 21 April 1998.

Claim 7 recites an isolated polypeptide having at least 80% amino acid sequence identity to a polypeptide of SEQ ID NO: 1400. The '772 patent teaches an isolated polypeptide having 100% amino acid sequence identity to SEQ ID NO: 1400 (see SEQ ID NO: 13; Figure 6 oncostatin, and column 4,

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brief description of the drawings for Figure 6) (see also, sequence search results in SCORE) (compare instant claim 7).

RESULT 1  
US-08-792-019B-13  
Sequence 13, Application US/08792019B  
Patent No. 5741772  
GENERAL INFORMATION:  
APPLICANT: CHANG, MING-SHI  
TITLE OF INVENTION: THE NEUROTROPHIC FACTOR NNT-1  
NUMBER OF SEQUENCES: 16  
CORRESPONDENCE ADDRESS:  
ADDRESSEE: AMGEN INC.  
STREET: 1840 DEHAVILLAND DRIVE  
CITY: THOUSAND OAKS  
STATE: CA  
COUNTRY: USA  
ZIP: 91320  
COMPUTER READABLE FORM:  
MEDIUM TYPE: Floppy disk  
COMPUTER: IBM PC compatible  
OPERATING SYSTEM: PC-DOS/MS-DOS  
SOFTWARE: PatentIn Release #1.0, Version #1.30  
CURRENT APPLICATION DATA:  
APPLICATION NUMBER: US/08/792,019B  
FILING DATE: 03-FEB-1997  
CLASSIFICATION: 514  
ATTORNEY/AGENT INFORMATION:  
NAME: COOK, ROBERT R.  
REGISTRATION NUMBER: 31,602  
REFERENCE/DOCKET NUMBER: A-442  
INFORMATION FOR SEQ ID NO: 13:  
SEQUENCE CHARACTERISTICS:  
LENGTH: 252 amino acids  
TYPE: amino acid  
STRANDEDNESS: single  
TOPOLOGY: linear  
MOLECULE TYPE: protein  
FEATURE:  
NAME/KEY: Protein  
LOCATION: 1..227  
FEATURE:  
NAME/KEY: Region  
LOCATION: -25..0  
US-08-792-019B-13

Query Match 100.0%; Score 1306; DB 1; Length 252;  
Best Local Similarity 100.0%; Pred. No. 9.7e-139;  
Matches 252; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

Qy 1 MGVLITQRTLLSLVLALLFFPSMASMAAIGSCSKEYRVLLGQLQKQTDLMQDTSRLLDPIYI 60  
|||||

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Db          1  MG/LLTQRTLLSLVLALLFPMSMAAIGSCSKEYRVLLGQLKQTDLMQDTSRLLDPI 60
Qy          61  RIQGLDVPKLRHCRERPGAFPSEETLRGLGRRGFLQTLNATLGCVLHRLADLEQRLPKA 120
          |||||||
Db          61  RIQGLDVPKLRHCRERPGAFPSEETLRGLGRRGFLQTLNATLGCVLHRLADLEQRLPKA 120
          |||||||
Qy          121 QDLERSGLNIEDLEKLQMARPNILGLRNNIYCMALLDNSDTAEPTKAGRGASQPPTPTP 180
          |||||||
Db          121 QDLERSGLNIEDLEKLQMARPNILGLRNNIYCMALLDNSDTAEPTKAGRGASQPPTPTP 180
          |||||||
Qy          181 ASDAFORKLEGCRFLHGYHRFMHSVGRVFESKWGESPNRSRRHSPHOALRKGVRRTPTSRK 240
          |||||||
Db          181 ASDAFORKLEGCRFLHGYHRFMHSVGRVFESKWGESPNRSRRHSPHOALRKGVRRTPTSRK 240
          |||||||
Qy          241 GKRLMTRGQLPR 252
          |||||||
Db          241 GKRLMTRGQLPR 252

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***Conclusion***

NO CLAIM IS ALLOWED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHERIE M. WOODWARD whose telephone number is (571)272-3329. The examiner can normally be reached on Monday - Friday 9:00am-5:30pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath N. Rao can be reached on (571) 272-0939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cherie M. Woodward/  
Examiner, Art Unit 1647